

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q64716

Michihiro HAZUMI

Application No.: 09/864,261

Group Art Unit: 3694

Confirmation No.: 3205

Examiner: Martin A. GOTTSCHALK

Filed: May 25, 2001

For: ELECTRONIC MEDICAL RECORD INFORMATION MANAGEMENT SYSTEM AND
METHOD THEREOF

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

Table of Contents

| | |
|---|----|
| I. REAL PARTY IN INTEREST..... | 2 |
| II. RELATED APPEALS AND INTERFERENCES..... | 3 |
| III. STATUS OF CLAIMS | 4 |
| IV. STATUS OF AMENDMENTS | 5 |
| V. SUMMARY OF THE CLAIMED SUBJECT MATTER | 6 |
| VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL | 10 |
| VII. ARGUMENT | 11 |
| CLAIMS APPENDIX..... | 17 |
| EVIDENCE APPENDIX..... | 26 |
| RELATED PROCEEDINGS APPENDIX..... | 27 |

I. REAL PARTY IN INTEREST

The real party in interest is NEC CORPORATION , by virtue of an assignment recorded by the Assignment Branch of the U.S. Patent and Trademark Office on May 24, 2001, at Reel 011854, Frame 0655.

II. RELATED APPEALS AND INTERFERENCES

To the knowledge and belief of Appellant, the Assignee, and the undersigned, there are no other appeals or interferences before the Board of Appeals and Interferences that will directly affect or be affected by the Board's decision in the instant Appeal.

III. STATUS OF CLAIMS

Claims 2, 8, 10, 14, 16, 18, 22, 25, 26 and 28-30 are all the claims pending in the present Application. Claims 2, 8, 10, 14, 16, 22, 25, 26 and 30 presently stand rejected under 35 U.S.C. § 102(b). In addition, claims 18, 28 and 29 stand rejected under 35 U.S.C. § 103(a). The rejected claims 2, 8, 10, 14, 16, 18, 22, 25, 26 and 28-30 are being appealed.

IV. STATUS OF AMENDMENTS

At the time of filing of this Brief, the Amendment under 37 C.F.R. § 1.116 filed on August 17, 2007 has not been entered. (See Advisory Action of October 23, 2007). Accordingly, the claims that are being appealed do not include changes made in the Amendment under 37 C.F.R. § 1.116 filed on August 17, 2007. All other all Amendments have been entered and considered by the Examiner.

The Appendix included with this Brief sets forth the claims involved in the appeal and reflects all of the claim amendments that have been entered by the Examiner.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Appellant's invention, as recited for example in claim 2, is related to an electronic record information management system and a method thereof. (See Abstract).

More specifically, Appellant's invention includes an electronic medical record information managing means, a plurality of electronic medical record showing means and a communication network that connects the two together.

The electronic medical record showing means includes a communications unit and a medical record terminal, which can make medical records for patients, and can transmit these record to the electronic medical record information managing means. The user can also make a request for medical records *via* the medical records terminal. (See page 6, ¶ [0070]).

The electronic medical record information managing means includes, *inter alia*, a control server that obtains one or more of said electronic medical records stored in said electronic medical record storer, and transmits the obtained one or more of said electronic medical records to said electronic medical record showing means through said second communication unit. (See page 4, ¶ [0046]).

Among other control server functions, the server can determine the access rights of the user. (See page 6, ¶ [0071]). As described below, various types of user authentication that are possible. For example, the control server 320 judges whether the hospital information system 100 and/or a user (doctor), accessed the electronic medical record information management center system 300, have an access right or not. Hereinafter, this judgment is referred to as **user authentication**. And also the control server 320 can judge whether the hospital information system 100 and/or the user have an access right or not for an electronic medical record of a

designated patient. Hereinafter, this judgment is referred to as **patient authentication**. At the case that this access is an access from the hospital information system 100 and/or the user that have the access right based on the judged result of the user authentication and the patient authentication. (See page 4, ¶ [0047]). If the user possesses proper access rights, access to the medical record is granted to the user. (See page 4, ¶ [0047]).

Specifically, independent claim 2 is directed to an electronic medical record information management system, including at least one electronic medical record information managing means; a plurality of electronic medical record showing means; and a communication network that connects the at least one electronic medical record information managing means to said plurality of electronic medical record showing means. (See, e.g., page 4, ¶ [0042] and FIG. 1). In the system of claim 2, each of said plurality of electronic medical record showing means includes a first communication unit for connecting to said communication network; and at least one first electronic medical record terminal that makes electronic medical records of patients and transmits said electronic medical records to said electronic medical record information managing means through said first communication unit and said communication network, and makes a request to transmit one or more of said electronic medical records stored in said electronic medical record information managing means, and transmits said request to said electronic medical record information managing means through said first communication unit, and shows one or more of said electronic medical records transmitted from said electronic medical record information managing means. (See page 4, ¶¶[0043]-[0046]).

Additionally, the electronic medical record information managing means includes a second communication unit for connecting to said communication network; an electronic

medical record storer that stores said electronic medical records that were transmitted from said electronic medical record showing means; and a control server that obtains one or more of said electronic medical records stored in said electronic medical record storer, and transmits the obtained one or more of said electronic medical records to said electronic medical record showing means through said second communication unit. (See page 5, ¶ [0052]).

Furthermore, the at least one first electronic medical record terminal further includes means for adding information to each of said electronic medical records and means for transmitting said electronic medical records having the added information to said electronic medical record information managing means through said first communication unit, the control server further makes said electronic medical record storer store said electronic medical records received from said electronic medical record showing means through said second communication unit, and said control server judges whether a user who transmitted said request is a user who has a second access right or not, and **when said user has said second access right**, said control server makes said electronic medical record storer store said electronic medical records. (See page 4, ¶ [0047]).

Independent Claim 8: This claim is similar in scope to claim 2 described above, however, the control server of the system judges whether a user who transmitted said request is a user who has a first access right or not, and **when said user has said first access right**, said control server obtains said electronic medical record of said patient designated by said request from said electronic medical record storer. (See page 4, ¶ [0047]).

Independent Claim 22: This claim is a method claim which corresponds to claim 8. The specification and line number, supporting the elements of this claim, can be found recited above with respect to claims 2 and 8.

Independent Claim 25: This claim is a method claim which corresponds to claim 2. The specification and line number, supporting the elements of this claim, can be found recited above with respect to claim 2.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

There are three issues on Appeal. The first issue is whether claims 2, 8, 10, 14, 16, 22, 25, 26 and 30 are improperly finally rejected under 35 U.S.C. § 102(b) as being anticipated by Ross, Jr. et al. (U.S. Pat. No. 5,823,948).

The second issue is whether claims 18 and 28 and 29 are improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over Ross and further in view of Wallace et al. (U.S. Pat. No. 6,564,121).

The third issue is whether the Examiner has properly considered Appellant's arguments during the prosecution of the present Application.

VII. ARGUMENT

Claim rejections – 35 U.S.C. § 102

Claims 2, 8, 10, 14, 16, 22, 25, 26 and 30 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Ross, Jr. et al. (U.S. Pat. No. 5,823,948). Appellant respectfully disagrees.

With regard to independent claim 2, Ross fails to disclose, or even suggest, at least the “control server [which] judges whether **a user who transmitted said request** is a user who has a second access right or not, and **when said user has said second access right, said control server makes said electronic medical record storer store said electronic medical records.**”

The Examiner maintains that this limitation is met by virtue of the “security validation module” of Ross and by virtue of the teachings of Ross at col. 3, lines 33-43. This is incorrect.

As set forth in the Amendment of March 8, 2007, the security validation module of Ross merely describes that personnel using Ross’ system must clearly **demonstrate their identity to gain access to the system** using a variety of methods depending on the system configuration. These methods range from passwords to smartcard technology to a magnetic card or other personal ID technologies. The user identity establishes “rights” to use various functions of the system, such as rights to generate prescriptions, to implement procedures, etc.

At column 3, lines 33-43, Ross describes that the computer system has security measures which limit access to the system. In Ross, a user approaches a station terminal and inserts a security card, which activates a station terminal. The user is then automatically identified and “areas” in which the user has “rights” are made available. All entries made by the user are then

attributed to the correct user. When entries are complete, the card is pulled out of the reader, and the system stores all entered data and the terminal is returned to a protective state.

This general description of a security validating procedure does not meet the claimed limitation. The validation procedures of Ross merely validate a user to access the entire system, and provide rights to certain functions or areas of the system. However, in Ross, **all users, once so validated, have automatic access to all patient records.** Thus, Ross does not disclose that a control server makes **a rights determination after a request for a patient record has been made.** Ross also does not disclose that based on that request, the medical record of the patient is sent to the user or to the server.

Although the above argument was presented to the Examiner, the Examiner has failed to even consider it. Instead, the Examiner simply asserted that “the **claim does not explicitly recite this feature,** and that the ‘**control server**’ of Ross makes the access determination concerning a user who transmits a request.” (See Office Action of June 4, 2007, pages 11-12). However, even this position by the Examiner is incorrect.

Initially, Appellant notes that Ross does not disclose a “control server” as the Examiner suggests. Such a feature is simply not recited in the disclosure of Ross. Additionally, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131; see also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, to the extent the Examiner was relying on the “security validation module” as the “control server,” the deficiencies of such an argument have been discussed above.

With regard to the Examiner’s assertion that the above feature (i.e. performing a rights determination **after** a request for a patient record is made) is not recited in the claims, this is also

incorrect. It is well known that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP § 2143.03; see also *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

With respect to claim 2, this claim recites that the “control server judges whether **a user who transmitted said request** is a user who has a second access right or not.” In other words, **the user must first transmit the request**, and only then the user’s access rights are determined. For at least this reason, Appellant respectfully asserts that the Examiner’s rejection was improper, and that the feature discussed in the Amendment of March 8, 2007 **is present** in the claims as they were presented.

In light of the above, Appellant respectfully asserts that independent claim 2 is patentable over Ross. Therefore, Appellant respectfully requests that the rejection of claim 2 be withdrawn.

With regard to independent claim 8, Appellant respectfully asserts that this claim is patentable for reasons analogous to those recited with respect to independent claim 2. As claims 10, 14, and 16 each depend from independent claims 2 or 8, they are patentable at least by virtue of their respective dependencies.

With further regard to claim 22, this claim recites a limitation similar to that of claim 2, which was discussed above. Therefore, claim 22 is patentable over Ross for reasons analogous to those recited with respect to claim 2. With regard to claim 26, this claim is patentable at least by virtue of its dependency from independent claim 22.

With further regard to independent claim 25, Appellant respectfully asserts that this claim is also allowable for reasons analogous to those recited with respect to claim 2. With respect to dependent claim 30, this claim is patentable at least by virtue of its dependency from claim 25.

Claim Rejections – 35 U.S.C. § 103

Claims 18, 28 and 29 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ross and further in view of Wallace et al. (U.S. Pat. No. 6,564,121). Appellant respectfully disagrees.

As set forth in the Amendment of March 8, 2007, there is no reason or motivation to combine the Ross and Wallace references. Ross is concerned with a system in which triage, reports, and medical records may be generated and supplied to physicians and nurses and a system in which information may be translated into patients records, instructions and prescriptions without delaying the burdening hospital personnel. The key to Ross' system is a centralized records storage system. Nurses and doctors enter data and text and dictate information into peripherals terminals. This information is then sent to a centralized server where, for example, dictation is converted to text and stored in a record. Thus, Ross solves the problem by using a centralized system.

By contrast, Wallace is concerned with reducing error in pharmaceutical dispensing systems. Traditional methods of dispensing pharmaceuticals are 1) using an automated devices in a central pharmaceutical dispensing area, 2) having an automated devices in a patient care area, and 3) having point-of-care information systems. Wallace rejects each of these centralized systems, and proposes a solution which is a distributed system. Thus, Wallace explicitly rejects the centralized system and moves to a more distributed system.

In other words, Ross teaches away from using a distributed system. It is well known that “[a] *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention.” *In re Geisler*, 116 F.3d 1465, 1471,

43 USPQ2d 1362, 1366 (Fed. Cir. 1997); see also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395 (2007). Appellant respectfully asserts that the Examiner did not appreciate that one skilled in the art, faced with the problem of Ross, i.e., increasing centralization of data, would not look to the distributed system of Wallace for a solution.

Moreover, Ross is concerned with increasing efficiency of data storage and collection into patient medical records, whereas the methods of Wallace would result in decreased efficiency because data must be encrypted and decrypted. Therefore, one would not look to the less efficient system of Wallace for a solution to Ross' problem.

In the Examiner's response, the Examiner simply "directs [the] Applicant to the motivation provided in the Office Action." This is improper. As set forth in MPEP § 707.07(f) "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and **answer the substance of it.**" Appellant respectfully asserts that the Examiner has not met this burden.

Furthermore, as described above, Ross is directed to a centralized system. In this system, personnel must clearly **demonstrate their identity to gain access to the system. Once validated, the users have automatic access to all patient records.** As such, there is no need in Ross to encrypt or decrypt the data being transmitted, as the user must have already been validated before even receiving access to the system. Simply adding additional encryption to the centralized system of Ross would be redundant.

However, even if, *arguendo*, the Ross and Wallace references could be combined, they still would not teach all of the recited claim limitations. Claims 18, 28 and 29 depend from independent claims 8 and 22 and 25, respectively, which have been shown above to be patentable over Ross. Wallace does not cure the deficiencies of Ross. Therefore, claims 18, 28

and 29 are patentable over the Ross and Wallace combination, and Appellant respectfully requests that the rejection of these claims be withdrawn.

Conclusion

For the reasons set forth above, Appellant respectfully requests that the members of the Board reverse the rejections of the appealed claims and find each of the claims allowable as defining subject matter that is patentable over the cited art of record.

This Appeal Brief is being filed via the USPTO Electronic Filing System (EFS). Appellant herewith petitions the Director of the USPTO to extend the time for filing this Appeal Brief for an appropriate length of time if necessary. Any fee due under 37 C.F.R. §41.37(a) and 37 U.S.C. § 1.17(c) is being paid via the USPTO Electronic Filing System (EFS).

The USPTO is also directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

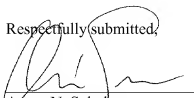
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Respectfully submitted,


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Registration No. 61,325

Date: February 5, 2008

CLAIMS APPENDIX

CLAIMS 2, 8, 10, 14, 16, 18, 22, 25, 26 and 28-30 ARE ON APPEAL:

1. *(canceled).*

2. An electronic medical record information management system, comprising:

at least one electronic medical record information managing means;

a plurality of electronic medical record showing means; and

a communication network that connects the at least one electronic medical record information managing means to said plurality of electronic medical record showing means, wherein:

each of said plurality of electronic medical record showing means comprises:

a first communication unit for connecting to said communication network; and

at least one first electronic medical record terminal that makes electronic medical records of patients and transmits said electronic medical records to said electronic medical record information managing means through said first communication unit and said communication network, and makes a request to transmit one or more of said electronic medical records stored in said electronic medical record information managing means, and transmits said request to said electronic medical record information managing means through said first communication unit, and shows one or more of said electronic medical records transmitted from said electronic medical record information managing means, and

said electronic medical record information managing means comprises:

a second communication unit for connecting to said communication network;

an electronic medical record storer that stores said electronic medical records that were transmitted from said electronic medical record showing means; and

a control server that obtains one or more of said electronic medical records stored in said electronic medical record storer, and transmits the obtained one or more of said electronic medical records to said electronic medical record showing means through said second communication unit,

wherein:

said at least one first electronic medical record terminal further includes means for adding information to each of said electronic medical records and means for transmitting said electronic medical records having the added information to said electronic medical record information managing means through said first communication unit, and

said control server further makes said electronic medical record storer store said electronic medical records received from said electronic medical record showing means through said second communication unit, and

said control server judges whether a user who transmitted said request is a user who has a second access right or not, and when said user has said second access right, said control server makes said electronic medical record storer store said electronic medical records.

3-7. (canceled).

8. An electronic medical record information management system, comprising:

at least one electronic medical record information managing means;
a plurality of electronic medical record showing means; and
a communication network that connects the at least one electronic medical record information managing means to said plurality of electronic medical record showing means, wherein:

each of said plurality of electronic medical record showing means comprises:
a first communication unit for connecting to said communication network; and
at least one first electronic medical record terminal that makes electronic medical records of patients and transmits said electronic medical records to said electronic medical record information managing means through said first communication unit and said communication network, and makes a request to transmit one or more of said electronic medical records stored in said electronic medical record information managing means, and transmits said request to said electronic medical record information managing means through said first communication unit, and shows one or more of said electronic medical records transmitted from said electronic medical record information managing means, and

said electronic medical record information managing means comprises:
a second communication unit for connecting to said communication network;
an electronic medical record storer that stores said electronic medical records that were transmitted from said electronic medical record showing means; and
a control server that obtains one or more of said electronic medical records stored in said electronic medical record storer, and transmits the obtained one or more of said electronic

medical records to said electronic medical record showing means through said second communication unit, wherein:

said control server judges whether a user who transmitted said request is a user who has a first access right or not, and when said user has said first access right, said control server obtains said electronic medical record of said patient designated by said request from said electronic medical record storer.

9. (canceled).

10. An electronic medical record information management system in accordance with claim 8, wherein:

said electronic medical record showing means further comprises:

a first access right information making unit that transmits first access right information with which said control server judges whether said user has said first access right or not to said electronic medical record information managing means through said first communication unit, wherein:

said control server judges whether said user who transmitted said request is said user who has said first access right or not, based on said first access right information received from said electronic medical record showing means through said second communication unit.

11-13. (canceled).

14. An electronic medical record information management system in accordance with claim 2, wherein:

said electronic medical record showing means further comprises:

a second access right information making unit that transmits second access right information with which said control server judges whether said user has said second access right or not to said electronic medical record information managing means through said first communication unit, wherein:

said control server judges whether said user who transmitted said request is said user who has said second access right or not, based on said second access right information received from said electronic medical record showing means through said second communication unit.

15. (canceled).

16. An electronic medical record information management system in accordance with claim 8, wherein:

said electronic medical record includes original data before new data are added.

17. (canceled).

18. An electronic medical record information management system in accordance with claim 8, wherein:

when data are transmitted between said electronic medical record information managing means and said electronic medical record showing means, said data are encrypted and said encrypted data are transmitted, and

when data are received at said electronic medical record information managing means and said electronic medical record showing means, said data are decrypted.

19-21. (canceled).

22. An electronic medical record information management method comprising:

- making electronic medical records of patients at a hospital information system;
- storing said electronic medical records in said hospital information system;
- transmitting said electronic medical records stored in said hospital information system to an electronic medical record information management center system;
- storing said transmitted electronic medical records of said patients at said electronic medical record information management center system;
- transmitting one or more of said electronic medical records to said hospital information system when one or more of said electronic medical records are requested;
- storing said transmitted one or more of said electronic medical records at said hospital information system;
- showing one or more of said electronic medical records at said hospital information system,

and

judging whether a user who requested to transmit one or more of said electronic medical records of said patients has a first access right or not, wherein:

when said user has said first access right, said requested one or more of said electronic medical records are transmitted to said hospital information system.

23-24. (canceled).

25. An electronic medical record information management method comprising:

making electronic medical records of patients at a hospital information system;

storing said electronic medical records in said hospital information system;

transmitting said electronic medical records stored in said hospital information system to an electronic medical record information management center system;

storing said transmitted electronic medical records of said patients at said electronic medical record information management center system;

transmitting one or more of said electronic medical records to said hospital information system when one or more of said electronic medical records are requested;

storing said transmitted one or more of said electronic medical records at said hospital information system;

showing one or more of said electronic medical records at said hospital information system;

and judging whether a user who requested to transmit one or more of said electronic medical records of said patients has a second access right or not, wherein:

when said user has said second access right, said electronic medical records made and transmitted from said hospital information system are stored in said electronic medical record information management center system.

26. An electronic medical record information management method in accordance with claim 22 further comprising:

adding new information to said electronic medical records stored in said electronic medical record information management center system from said hospital information system.

27. *(canceled).*

28. An electronic medical record information management method in accordance with claim 22 further comprising:

encrypting said electronic medical records when said electronic medical records are transmitted; and

decrypting said electronic medical records when said electronic medical records are received.

29. An electronic medical record information management method in accordance with claim 25, the method further comprising:

encrypting said electronic medical records when said electronic medical records are transmitted; and

decrypting said electronic medical records when said electronic medical records are received.

30. An electronic medical record information management method in accordance with claim 25, the method further comprising:

adding new information to said electronic medical records stored in said electronic medical record information management center system from said hospital information system.

adding new information to said electronic medical records stored in said electronic medical record information management center system from said hospital information system.

EVIDENCE APPENDIX

NONE

RELATED PROCEEDINGS APPENDIX

NONE

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SUBMISSION OF APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

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Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal of November 5, 2007, submitted herewith please find an Appeal Brief. The USPTO is directed and authorized to charge the statutory fee of \$510.00, and all other required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully (submitted),


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CUSTOMER NUMBER

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